



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/155,327	03/29/1999	SUZANNE CORY	11686	8469

7590

03/07/2003

SCULLY SCOTT MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530

EXAMINER

KAUSHAL, SUMESH

ART UNIT PAPER NUMBER

1636

DATE MAILED: 03/07/2003

33

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/155,327

Applicant(s)

CORY ET AL.

Examiner

Sumesh Kaushal Ph.D.

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's response filed on 12/30/02 has been acknowledged.

Claims 21-24 are pending and are examined in this office action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The references cited herein are of record in a prior Office action.

► *Applicants are advised to follow Amendment Practice under revised 37 CFR §1.121 (<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>). Each amendment document that includes a change to an existing claim, or submission of a new claim, **must include a complete listing of all claims** in the application. After each claim number, the status must be indicated in a parenthetical expression, and the text of each claim under examination (with markings to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.*

Specification

1. The amendment filed on 01/23/02 stands objected to under 35 U.S.C. 132 because it introduces **new matter into the disclosure**. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The newly submitted sequence listing is not supported by the specification as originally filed (*see rejection under 35 USC 112 1st para*).

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 01/23/02 have been disapproved because they introduce **new matter into the drawings**. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an

application. The original disclosure does not support the showing of changes made the nucleotide/amino acid sequence in figure 9A and 9B (*see rejection under 35 USC 112 1st para*).

Any proposal by the applicant for amendment of the drawing to cure defects must be embodied in a separate letter. Otherwise the application, unless in other respects ready for issue, cannot be corrected, and applicant must be so advised in the next action by the examiner (see MPEP 608.02(r)).

Claim Rejections - 35 USC § 112

3. Claims 21-24 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification (NEW MATTER) in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the same reasons of record as set forth in the office action mailed on 07/01/02.

Response to arguments

The applicant argues that the amendment filed on 01/23/02 sought to correct clerical errors in the protein sequences of SEQ ID NO:7 as depicted in Fig-8 (response, page 5 para.3). The applicant argues that the clerical errors corrected in the protein sequences of SEQ ID NO:9 is same as depicted in Fig-1 (response, page 6 para.1). The applicant argues that the clerical errors corrected in the nucleotide sequences of SEQ ID NO:6 as well as SEQ ID NO:8 are same as depicted in Fig 9A and 9B respectively of Fig-9A and 9B of the PN8965 (response, page 6 para.2). The applicant admits that originally filed Fig-9A and 9B contain the same typographical errors as the original sequence listing. The applicant concluded that the substitute drawing don not introduce new matter and are fully supported by the application as filed and by the priority documents (response, page 6 para.3).

However, this is found NOT persuasive because recent amendment to SEQ ID NO: 6, 7, 8 and 9 are not supported WO9735971 (PCT/AU97/00199, filed 03/27/97) and PN8965 filed 03/27/96. i) Even though applicant argues that recent amendments are supported by the priority documents the applicant fails to point out where in the figures 1 and 8 of the instant specification

Art Unit: 1636

there is support for the amendments as proposed. Figure 1 and 8 of instant specification are sequence compression of bcl-w and bcl-2 related amino acid sequences.

✓ ii) Similarly the applicant fails to point out where in figure 9A and 9B of PN8965, 03/27/96 there is support for amendment as proposed. Figure 9A and 9B of WO9735971 and figure 9A and 9B of PN8965 are not identical. Furthermore, figure 9A and 9B of WO9735971 are fragments of amino acid sequences (9A i-iv, 9B i-iv), whereas figure 9A (636bp) and 9B(808bp) of PN8965 are nucleotide sequences.

ii) In addition, the instant specification fails to incorporate the priority document (PN8965) by reference. There is no evidence that any information left out of this application was intended to be in the instant application at the time of filing. Therefore, the recent amendment in the SEQ ID NO (s) is considered to be a **new matter**, which cannot be supported by PN8965.

Furthermore, depending on circumstances such as the adequacy of the original disclosure, the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter. See Ex parte Vander Wal, 109 USPQ 119, 1956 C.D. 11, 705 O.G. 5 (Bd. App. 1955) (physical properties), Ex parte Fox, 128 USPQ 157, 1960 C.D. 28, 761 O.G. 906 (Bd. App. 1957) (new formula) and Ex parte Ayers, 108 USPQ 444 (Bd. App. 1955) (new use). Accordingly, the amendment of the nucleotide sequences of SEQ ID NO:6 and 8, and amino acid sequence of SEQ ID NO:7 and 9 along with newly filed Fig-9A and 9B clearly constitutes incorporation of new matter in the instant specification see MPEP § 608.04.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1636

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is 703-305-6838. The examiner can normally be reached on Mon-Fri. from 9AM-5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yucel Irem Ph.D. can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-8724 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

S. Kaushal
PATENT EXAMINER



JEFFREY FREDMAN
PRIMARY EXAMINER